

REMARKS

By this Amendment, Applicant has amended claim 57 and canceled claim 70 without prejudice or disclaimer. No new matter has been added. Claims 1-69 and 71-74 are present in the application. Of those claims, claims 16-56 have been withdrawn from consideration on the merits as being directed to a non-elected invention. Thus, claims 1-15, 57-69, and 71-74 are pending on the merits.

I. Withdrawal of Claims 16-56 from Consideration

In the Office Action, Applicant's election with traverse to prosecute claims 1-15 and 57-74 has been acknowledged, and the Examiner has made the restriction requirement included in the Office Action of December 31, 2007, final. Thus, claims 16-56 have been withdrawn from consideration. Claims 1-15, 57-69, and 71-74 (claim 70 has been canceled without prejudice or disclaimer) are pending on the merits.

II. Claim Rejection under 35 U.S.C. § 102 (b) based on Brown

In the Office Action, claims 1-15 and 57-74 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,653,795 to Brown ("Brown"). Office Action at 2. Claims 1 and 57 are the only independent claims included in the § 102(b) rejection based on Brown. Applicant respectfully traverses the rejection of independent claims 1 and 57 because Brown fails to disclose all of the subject matter recited in each of those claims for at least the reasons explained in more detail herein.

A. Rejection of Independent Claim 1

Brown does not anticipate independent claim 1 under 35 U.S.C. § 102(b) because Brown does not teach all of the subject matter recited in independent claim 1. See M.P.E.P. § 2131. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Id. Furthermore, a rejection under § 102 is proper only when the claimed subject matter is identically described or disclosed in the prior art. In re Arkley, 455 F.2d 586, 587 (C.C.P.A. 1972). Moreover, the identical invention must be shown in "as complete detail as is contained in the . . . claim." M.P.E.P. § 2131.

Applicant's independent claim 1 is directed to a pigment composition, including, *inter alia*, at least one calcium carbonate and "at least one anionic dispersant present in an amount sufficient to overdisperse the at least one calcium carbonate" Brown fails to disclose at least this subject matter recited in independent claim 1.

Brown discloses a method for forming fillers for cellulosic products, and products made using the fillers. Brown does not teach, however, a pigment composition including at least one anionic dispersant present in an amount sufficient to overdisperse a calcium carbonate component. Indeed, Brown is completely silent with respect to overdispersal.

In contrast, the present application discloses that overdispersion of the at least one anionic dispersant may advantageously improve printing properties. For example, as shown in Example 3 at pp. 23-24 of the present application, an anionic polymer was added in an amount as much as four times greater than the optimal dose for minimum rheology. The subsequent analysis of the pigment coatings prepared according to

Example 3 showed that the technique of overdispersing improved both the high print density and visual print quality. In particular, at doses for optimal minimal rheology (i.e., 0.5% maleic acrylic copolymer in the example shown), the sample was visually assessed as ranging between "slight bleeding" and "moderate to bad bleeding." For a sample including 2.0% maleic acrylic copolymer, however, the sample was assessed as "quite good" for print quality and had higher print density across the color spectrum.

As outlined above, Brown fails to teach at least one anionic dispersant present in an amount sufficient to overdisperse the calcium carbonate, as recited in independent claim 1. For at least this reason, independent claim 1 is patentably distinguishable from Brown. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claim 1 under 35 U.S.C. § 102(b) based on Brown.

B. Rejection of Amended Independent Claim 57

Brown also fails to disclose all of the subject matter recited in Applicant's amended independent claim 57. Therefore, the rejection of independent claim 57 under 35 U.S.C. § 102(b) based on Brown should be withdrawn.

Applicant's amended independent claim 57 is directed to a pigment composition including, *inter alia*, "a solids concentration ranging from 40% to 65% solids." Brown fails to teach at least this subject matter recited in amended independent claim 57. Rather, Brown teaches slurries with solids concentrations in the range of 1-30%. (Col. 8, lines 33.) Moreover, Brown teaches that "[b]est results are achieved by diluting the aqueous mineral slurry from about 1 to no more than 10% solids by weight to facilitate selective aggregation." (Col. 8, lines 33-35 (emphasis added).) As a result,

Brown fails to disclose a pigment composition having a solids concentration ranging from 40% to 65% solids, as recited in amended independent claim 57.

For at least the above-outlined reason, Applicant's amended independent claim 57 is patentably distinguishable from Brown. Therefore, Applicant respectfully requests reconsideration and withdrawal of the § 102(b) rejection of independent claim 57 based on Brown.

III. Conclusion

For at least the reasons set forth above, Applicant respectfully submits that independent claims 1 and 57 are allowable. Claims 2-15, 58-69, and 71-74 depend from a corresponding one of allowable independent claims 1 and 57 and should be allowable for at least the same reasons that independent claims 1 and 57 are allowable. Furthermore, independent claims 16, 33, and 44, and dependent claims 17-32, 34-43, and 45-49, which depend respectively therefrom, should be allowable for reasons at least similar to those outlined above with respect to independent claim 1. Therefore, Applicant respectfully requests rejoinder, examination, and allowance of withdrawn claims 16-49.

For at least the above-outlined reasons, Applicant respectfully requests reconsideration of this application, withdrawal of the claim rejection, and allowance of pending claims 1-49, 57-69, and 71-74.

If the Examiner believes that a telephone conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicant's undersigned attorney at (404) 653-6559.

Applicant respectfully submits that the Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 29, 2008

By: /Christopher T. Kent/
Christopher T. Kent
Reg. No. 48,216